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Serial No. 09/764,558
Response to Official Action

In the Drawings

There are no amendments to the drawings.

Remarks

Claim 1 requires among other limitations, an indication selected by a player from said plurality of indications, said indication submitted by the player to said computer over said computer network. Further, Claim 24 requires among other limitations, an indication selected by the player from said list of indications and submitted by the player to said computer. Applicant respectfully submits that this limitation is not taught or suggested in the cited prior art.

U.S. Patent No. 6,418,419 ("Nicboer et al.") teaches an automatic matching system, not a system where the player selects an indication and submits the selection over a network as required by Claims 1 and 24. For example, Nicboer et al. teaches "[a]n apparatus and method of automatically and anonymously buying and selling positions in fungible properties between subscribers" (Abstract) (emphasis added). In fact, the title of the invention is "Automated System For Conditional order Transactions In Securities Or Other Items In Commerce." (Title of the Invention) (emphasis added). In addition, Nicboer et al. goes on to state that the "system can automatically execute (i.e. place orders on the secondary security and report the transaction in the primary security) bids/offers when they intersect. To place an order for the secondary security, the system can automatically contact the appropriate exchange (e.g. NYSE) to place the bid/offer for the secondary security." (Col. 4, lines 15-21) (emphasis added). Nowhere however, does Nicboer et al. teach or suggest that a player or trader selects and indication and submits the selected indication. Rather, Nicboer et al. repeatedly emphasizes that prior art system are not "efficient" and that the system taught in Nicboer et al. in-

creases efficiency due to the automatic matching of bids and offers. (See, Col. 7, lines 63-67 & Col. 15, lines 63-64).

However, the automated system taught in Nicboer et al. is undesirable because the best bid ask price for the indication may not be the only factor that must be considered prior to selection. A player/trader may prefer an offer that is not the lowest price, but may be preferred based on other factors, such as place of delivery. For example, a player/trader may decide to select a higher price for a particular commodity based on where that commodity is to be delivered. The time of year may also be a factor in determining delivery preferences, just to name a few factors. These dynamic decisions may be made by the player/trader who can react to market conditions, at least in part because the present system provides for "an indication selected by a player from said plurality of indications, said indication submitted by the player to said computer over said computer network" as required by Claims 1 and 24.

It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that a primary objective of Nicboer et al. is to provide an automatic matching system for automatically providing matching transactions in order to complete trades. Therefore, any modification of Nicboer et al. according to the Claims 1 and 24 to require player selection and submission would destroy the objective of the system taught in Nicboer et al.

Accordingly, because Nicboer et al. fails to teach or suggest, an indication selected by a player from said plurality of indications, said indication submitted by the player to said computer over said computer network as required by Claims 1 and 24, but rather teaches directly away from this limitation using an automated system, Nicboer et al. cannot render Claims 1 or 24 obvious.

Claim 1 also requires among other limitations, a database accessible by said computer containing a plurality of indications submitted by and identified with players of the system to said computer over said computer network, wherein each of said plurality of indications identified with a particular player, relates to a bid or offer for a specified number of units of a specified commodity at a specified unit price. Further, Claim 24 requires among other limitations, an indication including a specified number of units of a specified commodity at a specified unit price by a particular identified player. Applicant respectfully submits that this limitation is not taught or suggested in the cited prior art.

Nicboer et al. teaches “[a]n apparatus and method of automatically and anonymously buying and selling positions in fungible properties between subscribers” (Abstract) (emphasis added). In differentiating over the prior art, Nicboer et al. states “[t]he present invention is an anonymous system; the current verbal network is neither efficient nor anonymous.” (Col. 1, lines 39-41; See, Col. 15, lines 63-63 “The system is anonymous”; See *also* Col. 3, line 37) (emphasis added). This is not an insignificant difference. Rather, it is important that a player/trader know with whom they are dealing so that they may assess the risk involved in the transaction. For example, a particular indication may be priced below market price, however, the indication is offered by an

unreliable source that may or may not be able to fulfill any contract entered into. By allowing the player/trader to identify with whom they are potentially dealing, the player/trader may make an informed decision with regard to the particular indication. This cannot be done with the system taught in Nicboer et al.


It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that a primary objective of Nicboer et al. is an anonymous matching system for anonymously matching active bids and offers. (See, Abstract, "A communication system is described which allows subscribers to communicate anonymously for the purpose of effecting transactions") (emphasis added). Therefore, any modification of Nicboer et al. according to the Claims 1 and 24 to require player selection and submission would destroy the objective of the system taught in Nicboer et al.

Accordingly, because Nicboer et al. fails to teach or suggest, a database accessible by said computer containing a plurality of indications submitted by and identified with players of the system to said computer over said computer network, wherein each of said plurality of indications identified with a particular player, relates to a bid or offer for a specified number of units of a specified commodity at a specified unit price as required by Claims 1 and 24, but rather teaches directly away from this limitation using an anonymous system, Nicboer et al. cannot render Claims 1 or 24 obvious.

It is respectfully submitted that claims 1 – 25, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

March 30, 2006



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